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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,857	09/19/2003	Peter Damm	1378B	8369

7590 06/30/2004
STRIKER, STRIKER & STENBY
103 East Neck Road
Huntington, NY 11743

EXAMINER

LAMM, MARINA

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/665,857

Applicant(s)

DAMM ET AL.

Examiner

Marina Lamm

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-15, 17, 18, 20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 12-15, 17, 20 and 21 is/are rejected.
- 7) ☒ Claim(s) 18 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/744,892.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claims 12-15, 17, 18, 20 and 21 are pending in this application filed 9/19/03 which is a divisional of application S.N. 10/159,310, filed 5/31/02, now US Patent No. 6667,028, which is a divisional of application S.N. 09/744,892, filed 1/31/01, now US Patent No. 6,488,922. Claims 16 and 19 have been cancelled by the preliminary amendment filed simultaneously.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 12-15, 17, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hocquaux et al. (US 5,328,914) either alone or in view of Tuloup et al. (US 5,132,106).

a. Hocquaux et al. alone

Hocquaux et al. teach pyrimidine 3-oxide derivatives of formula (I), wherein R1 and R2 can be NH₂ group and R3 can be C1-C4 alkyl group which may carry an alkoxy group or a benzene nucleus. See Abstract. The compounds of Hocquaux et al. are used for treating hair loss (alopecia). See Abstract. The compounds of Hocquaux et al. are formulated into cosmetically acceptable carriers and applied to the alopecic area of the scalp one or two times a day with or without subsequent rinsing, optionally with a

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massage to enhance penetration. See col. 5, lines 4-11, 39-42; Examples. The Hocquaux reference does not explicitly teach the claimed compounds. However, the compounds of Hocquaux et al. are structural isomers (tautomers) of the claimed compounds and have the same empirical formula as the claimed compounds. Further, the compounds of Hocquaux et al. are used for the same purpose as the claimed compounds, i.e. for treating hair loss. Nothing unobvious is seen in substituting the known isomer for the structurally similar isomer, as taught by Hocquaux et al., since such structurally related compounds suggest one another and would be expected to share common properties absent a showing of unexpected results. *In re Norris*, 84 USPQ 458 (1950). Therefore, in the absence of evidence of unexpected results due solely to the use of the claimed tautomers vs. compounds of Hocquaux et al., it would have been obvious to one having ordinary skill in the art at the time of the invention to use the compounds of Hocquaux et al. with a reasonable expectation of deriving the same cosmetic effect, because the prior art says that their compounds are effective for the treatment of hair loss. With respect to Claim 15, the prior art does not explicitly teach massaging scalp for the claimed time interval. However, the determination of optimal massage time by routine experimentation is obvious to one of ordinary skill in this art absent showing of criticality of the claimed time interval. One having ordinary skill in the art would have been motivated to do this to obtain the optimal penetration of the composition as suggested by Hocquaux et al.

b. Hocquaux et al. in view of Tuloup et al.

Hocquaux et al. teach pyrimidine 3-oxide derivatives of formula (I) useful for the treatment of hair loss as discussed above. The reference does not explicitly teach the claimed tautomeric form of the compounds. However, Tuloup et al. teach pyrimidine 3-oxide derivatives which exist in the tautomeric forms, wherein both forms may be present in variable proportions. See Formulae (I) and (IB) @ col. 1 and 2. The compounds of Tuloup et al. are used for the treatment of hair loss. Therefore, absent showing of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use either tautomeric form of the pyrimidine 3-oxide derivatives of Hocquaux et al. with a reasonable expectation of deriving the same cosmetic effect as suggested by Tuloup et al.

Thus, the claimed invention as a whole was clearly *prima facie* obvious.

Allowable Subject Matter

3. Claim 18 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 5,360,804; US 5,466,694; US 5,756,092; EP 427 625; GB 2 183 632.

5. No claim is allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (571) 272-0618. The examiner can normally be reached on Mon-Fri from 11am to 5pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached at (571) 272-0602.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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6/26/04


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